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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/662,418	09/16/2003	Michael S. Chisholm	081903-0304651	081903-0304651 2375	
43569	7590 05/17/2006		EXAM	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP			YOON, TAE H		
1909 K STR WASHINGT	EE1, N.W. TON, DC 20006		ART UNIT	PAPER NUMBER	
	,		1714		
			DATE MAILED: 05/17/2006		

Please find below and/or attached an Office communication concerning this application or proceeding.

			/ /			
	Application No.	Applicant(s)				
Advisory Action	10/662,418	CHISHOLM ET AL.				
Before the Filing of an Appeal Brief	Examiner	Art Unit				
	Tae H. Yoon	1714				
The MAILING DATE of this communication appe	ars on the cover sheet with the o	correspondence add	ress			
THE REPLY FILED 27 April 2006 FAILS TO PLACE THIS APP		•				
 The reply was filed after a final rejection, but prior to or o this application, applicant must timely file one of the folloplaces the application in condition for allowance; (2) a No (3) a Request for Continued Examination (RCE) in comp following time periods: The period for reply expires 3 months from the mailing date of 	n the same day as filing a Notice of wing replies: (1) an amendment, a otice of Appeal (with appeal fee) in liance with 37 CFR 1.114. The repl	f Appeal. To avoid ab ffidavit, or other evide compliance with 37 (ence, which CFR 41.31; or			
b) The period for reply expires <u>s</u> months from the mailing date of the final rejection. b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.						
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f). Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). NOTICE OF APPEAL						
2. The Notice of Appeal was filed on A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).						
AMENDMENTS 3. The proposed amendment(s) filed after a final rejection, (a) They raise new issues that would require further co (b) They raise the issue of new matter (see NOTE belo (c) They are not deemed to place the application in beloappeal; and/or	nsideration and/or search (see NO ow); tter form for appeal by materially re	TE below); educing or simplifying				
(d) They present additional claims without canceling a NOTE: (See 37 CFR 1.116 and 41.33(a)).		jected claims.				
 4. The amendments are not in compliance with 37 CFR 1.1 5. Applicant's reply has overcome the following rejection(s 6. Newly proposed or amended claim(s) would be a the non-allowable claim(s). 7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro The status of the claim(s) is (or will be) as follows:): <u>Prior art (Sakamoto) 102/103 rej</u> llowable if submitted in a separate will not be entered, or b) w	ection against claims , timely filed amendm	7-9. ent canceling			
Claim(s) allowed: Claim(s) objected to: Claim(s) rejected: Claim(s) withdrawn from consideration: AFFIDAVIT OR OTHER EVIDENCE 8. The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good an and was not earlier presented. See 37 CFR 1.116(e).						
9. The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to c showing a good and sufficient reasons why it is necessar 10. The affidavit or other evidence is entered. An explanatio REQUEST FOR RECONSIDERATION/OTHER	overcome <u>all</u> rejections under appe by and was not earlier presented. So on of the status of the claims after e	al and/or appellant fa See 37 CFR 41.33(d)(entry is below or attac	ils to provide a 1). hed.			
 11. The request for reconsideration has been considered busee attachment. 12. Note the attached information Disclosure Statement(s) 			nce because:			
12. Note the attached Information Disclosure Statement(s).	(PTU/SB/08 of PTO-1449) Paper	NO(S).				

U.S. Patent and Trademark Office PTOL-303 (Rev. 7-05)

13. Other: _

Tae H Yoon Primary Examiner Art Unit: 1714

ATTACHMENT TO ADVISORY ACTION

Applicant asserts that examples of Sakamoto do not teach the instant amount of a polyfunctional monomer, but the disclosure of the prior art is not limited to working examples. See *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples. Sakamoto teach the instant amount of a polyfunctional monomer and molecular weight in claim 1 wherein 0.3 % by weight of a polyfunctional monomer is taught. Rejection of claims 1-6 is maintained, but rejection of claims 7-9 reciting 0.5 to 100 wt.% a polyfunctional monomer is withdrawn.

With respect to 112, 2nd PP rejection, applicant asserts that "soluble" polymers may be soluble in any number of solvents, and the examiner partially agrees with such assertion. Said any number of solvents would have similar polarities, but water can be a solvent too. A polymer soluble in a non-polar solvent would not be soluble in water, and thus the recitation a solvent(s) would be needed. Rejection of claims 1-9 is maintained.

Applicant failed to submit terminal disclaimers. Thus, double patenting rejection of claims 1-9 is maintained,

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

Application/Control Number: 10/662,418 Page 3

Art Unit: 1714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner
Art Unit 1714

THY/May 12, 2006